

PATENT APPLICATION
Attorney Docket No.: TRV03-0001-1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE PATENT APPLICATION OF)	
Dennis R. Berman)	Examiner: Lec, Benjamin William
Application No.: 10/815,341)	Group Art Unit: 3714
Filing Date: March 31, 2004)	Confirmation Number: 8341
Title: METHODS OF SELECTING LOCK-IN TRAINING)	
COURSES AND SESSIONS)	

SUBMITTAL OF MATERIALS FROM CO-PENDING APPLICATIONS

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Recently, the Federal Circuit, in *McKesson Information Solutions, Inc., v. Bridge Medical, Inc.* (2005-1517) affirmed a District Court's determination that a patent was unenforceable due to inequitable conduct. The inequitable conduct was based upon a patent attorney's nondisclosure of office actions from co-pending applications.

In light of *McKesson*, I have attached an office action from a co-pending application of the present application. You may or may not find this office action to be material to the present application.

Respectfully submitted,



Hoyt A. Fleming III
Registration No. 41752

Date: July 31, 2007

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/613,564	07/02/2003	Dennis R. Berman	TRV03-0001	5486

28422 7590 07/18/2007
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BOISE, ID 83714

EXAMINER

GISHNOCK, NIKOLAI A

ART UNIT	PAPER NUMBER
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3714

MAIL DATE	DELIVERY MODE
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07/18/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/613,564

Applicant(s)

BERMAN, DENNIS R.

Examiner

Nikolai A. Gishnock

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 April 2007.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 28,29,32-34,37 and 38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 28,29,32-34,37 and 38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

In response to the Applicant's remarks, filed 4/6/2007, claims 1-27, 30, 31, 35, & 36 are cancelled. Claims 28, 29, 32-34, 37, & 38 are pending.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 28, 29, 32-34, 37, & 38 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. It is unclear where the limitation, "the answer to the question including a keyword, the keyword having n characters, where n is greater than 2", is found in the specification.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35

U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. Claims 28, 29, 32-34, 37, & 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over New, III (US 6,155,834), hereinafter known as New III, in view of Boon (US 6,022,221), hereinafter known as Boon. New III teaches a method for training a learner to memorize a keyword, the method performed by a computer system having a processor, a memory, and a display (6:1-2 & 6:16-18), the method comprising: presenting on the display, utilizing a graphical user interface, a keyword (method processes including a show-only process which displays the target word on the display for a show interval and accepts a response from the student, 3:44-46), the keyword having n characters, where n is greater than 2 (Figure 6(b) is a screen display illustrating a show of the target word, "butterfly", 16:50-51; having 9 characters); presenting on the display, using the graphical user interface, a contextual presentation, the contextual presentation including locations for the n characters of the keyword ("Show Target Word with Blanks", the current target word, including blanks substituted for letters, is shown continuously, 17:4-6); receiving a first received character entered into a keyboard by the learner ("Response on Time?", Figure 6(a), Item 910); before receiving any other character via the keyboard, determining if the first received character is equal to the first

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character of the keyword ("Correct Letter?", Figure 6(a), Item 920); if the first received character is not equal to the first character of the keyword, then presenting on the display, using the graphical user interface, generating a first indication ("Is blank = ?", Figure 6(a), Item 940); and if the first received character is equal to the first character of the keyword, then presenting on the display, using the graphical user interface, displaying the first received character in the location of the first character of the keyword ("Substitute Correct Letter For Blank", Figure 6(a), Item 930) [Claims 28, 33, & 37]. What New III fails to teach is presenting on the display, a question and an answer to the question, the answer to the question including a keyword; and a contextual presentation including the question and a portion of the answer to the question, the portion of the answer to the question including at least one non-keyword, and where, the first indication not changing the identity of the character displayed in the location of the first character of the keyword [Claims 28, 33, & 37]. However, Boon teaches a teaching method and system for presenting questions to a user who responds with answers, including a display screen showing display of a question/answer pair (12:32-46; also Figures 15, 17, & 18), a portion of the answer to the question including at least one non-keyword (the question of the question/answer pair is the verb 'to beat', in its first form, "beat". The expected response, "beat/beaten", is shown below the answer line, 12:37-40; in this case, "beat" is the keyword, and "beaten" is the non-keyword). Boon also teaches where an alphabetic character in the incorrect answer is typed into the blank line, and compared against the alphabetic character in the correct answer. Since the response is negative, the logic alerts the user by displaying the incorrect character and highlighting the mistake (Figure 18 is a display screen showing display of a q/a in response to an incorrect answer. The incorrect response is shown above the answer line with the carat symbol below it pointing to the error. The answer line now shows the correct part of the answer already given plus the next additional character from the correct answer, 12:61-

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13:5). Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have adapted the method of New III, to display a question/answer pair, a portion of the answer including at least one non-keyword, and displaying a first indication on the entry of an incorrect response, such that the first indication does not change the identity of the character displayed in the location of the first character of the keyword, as taught by Boon, so that the user needn't input these letters again, but only complete the answer starting at the letter after the incorrect answer [Claims 28, 33, & 37].

New III teaches receiving a second received character entered into the keyboard by the learner (Figure 6(a), branch from Item 960, "Substitute * for blank", back to Item 910, "Response on Time?"); before receiving any other character via the keyboard, determining if the second received character is equal to the first character of the keyword (Figure 6(a), Item 920, "Correct Letter?"); if the second received character is not equal to the first character of the keyword, then presenting on the display, using the graphical user interface, the first indication (Figure 6(a), Item 940, "Is blank = *?", then branch to Figure 6(a), Item 950); and if the second received character is equal to the first character of the keyword, then presenting on the display, using the graphical user interface, displaying the second received character in the location of the first character of the keyword (branch to Figure 6(a), Item 930, "Substitute Correct Letter for Blank") [Claims 29, 33, & 38]. New III teaches determining that the first received character is equal to the first character of the keyword; based at least in part upon determining that the first received character is equal to the first character of the keyword, determining to present the first received character on the display, using the graphical user interface ("Substitute Correct Letter For Blank", Figure 6(a), Item 930); and if the second received character is not equal to the second character of the keyword, then presenting on the display, using the graphical user interface, a first indication, the first indication not changing the identity of the character displayed in the

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location of the second character of the keyword (Figure 6(a), Item 920, "Correct Letter?"); and if the second received character is equal to the second character of the keyword, then presenting on the display, using the graphical user interface, the second received character in the location of the second character of the keyword (branch to Figure 6(a), Item 930 "Substitute Correct Letter for Blanks") [Claim 33].

6. Claims 32 & 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over New III and Boon, as applied to claims 28 & 33 above, and further in view of Stansvik (US 6,905,340 B2), hereinafter known as Stansvik. New III and Boon teach all the features as demonstrated above in the rejections of claims 28 & 33. Boon teaches receiving a request from the learner to present a hint on the display (in the GUI version of LANG, hints that would appear on the response line either blink the correct area on the screen; and then presenting the second indication on the display using the graphical interface, 16:36-40) [Claims 32 & 34]. What New III and Boon fail to explicitly teach is where the request includes receiving data that indicates the selection of a hint icon [Claims 32 & 34]. However, Stansvik teaches a computer based method and system for teaching languages, in which a user may seek a hint by selecting an icon (10:65-66). Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have made the selection of a hint in the form of an icon, as taught by Stansvik, in the GUI system and method for memorizing words of New III and Boon, in order to allow the hint to be requested with a mouse pointer [Claims 32 & 34].

Response to Arguments

7. Applicant's arguments with respect to claim 28, filed 4/6/2007, see page 7, have been considered but are moot in view of the new ground(s) of rejection, which were necessitated by amendment to the claims.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nikolai A. Gishnock whose telephone number is 571-272-1420. The examiner can normally be reached on M-F 8:30a-5p.

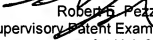
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert E. Pezzuto can be reached on 571-272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

NAG

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7/7/2007


Robert E. Pezzuto
Supervisory Patent Examiner
Art Unit 3714